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Paul D. Greeley, Esq. Ohlandt, Greeley, Ruggiero & Perle, L.L.P. 10th Floor One Landmark Square Stamford, CT 06901-2682				
EXAMINER				
NGUYEN, TAN D				
ART UNIT		PAPER NUMBER		
3689				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/027,658

**Applicant(s)**

SHUMPERT, JAMES MICHAEL

**Examiner**

Tan Dean D. Nguyen

**Art Unit**

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 and 12-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_



**DETAILED ACTION**

***Response to Amendment***

The amendment of 7/14/08 has been entered. Claims 1-9 (method), and 10, 12-18 (system) are pending and rejected as followed. Claim 11 has been canceled.

***Claim Rejections - 35 USC § 103***

**1. Claims 1-9 (method), 10, 12-18 (system) are rejected under 35 U.S.C. 103(a) as being unpatentable over (1) Applicant's Admitted Prior Art (AAPA) in view of (2) ROSS or vice versa.**

As of 11/8/2007, independent method claim 1 is as followed:

1. (previously presented) A computer-implemented method for determining authenticity of a business partner in response to a request of a user comprising:

- (a) receiving a request of a user to determine authenticity of a business partner;
- (b) receiving an identity of said business partner from said user;

(c) matching said identity of said business partner to a business data record of a business that is one of a plurality of businesses by searching at least one database for said business data record having at least one data attribute that matches said identity, and

(d) processing at least one said data attribute of the matched said business data record according to a set of authentication rules to determine if said business partner is authentic, wherein said at least one data attribute represents at least one credential of said business partner; and

- (e) notifying said user of the results.

Note that in claim 1,

1) in step (a), the phrase “to determine .... business partner” is not a positively recited method step but, rather, is mere intended use of the received request and thus having no patentable weight. See MPEP 2173.05 (q), 2106, and 2111.04, which indicate that a method claim requires active, positive steps.

2) Similarly in step (d), the phrase “to determine if .... business partner” is not a positively recited method step but, rather, is mere intended use of the processed data attribute and thus having no patentable weight. See MPEP 2173.05 (q), 2106, and 2111.04, which indicate that a method claim requires active, positive steps.

3) in step (e), the term “the results” lacks antecedent basis and it's not clear what results the claim is talking about.

Therefore, independent method claim 1 basically requires:

1. (previously presented) A computer-implemented method for determining authenticity of a business partner in response to a request of a user comprising:

(a) receiving a request of a user;

(b) receiving an identity of said business partner from said user;

(c) matching said identity of said business partner to a business data record of a business that is one of a plurality of businesses by searching at least one database for said business data record having at least one data attribute that matches said identity, and

(d) processing at least one said data attribute of the matched said business data record according to a set of authentication rules; and

(e) notifying said user of the results (any information or event or conclusion).

**AAPA**, as cited on page 1, line 8 to page 2, line 14 (or US 2003/0120614, paragraphs [0003]-[0004]) fairly teaches current method for determining authenticity of a business partner in response to a request of a user in an off-line or manual technique by entering the request of a user into a computer system associated with the business database, the authentication process then employs a matching technique to find a data record of a business in the business database that matches the identifying data of the business partner. The data record of the matched business is then assessed for authenticity. The request also provides some data that identifies the business partner {see page 1, lines 30-31 "*Current methods .... Use an off-line technique...*}. **AAPA** fairly teaches the claimed invention except for carrying out using a computer or "computer-implemented" as shown in the preamble and carrying out step (d) according to a set of authentication rules.

In a similar method for verification of user authentication, **ROSS** fairly teaches a computer-implemented method for a subject or data remote authentication submitted by a remote user to determine whether the subject/data is authenticate (or verification of requested subject /data or user authentication) and according to a set of authentication rules (d) {see [0004], [0008], [0014], [0025][0026], Fig. 1. The term "subject" refers to any person or entity being authenticated. User authentication is the process of determining whether the subject is who he claims to be. Note that ROSS

also discloses the carrying out the steps online in the case of Web forms {see [0004], and [0008]}. It would have been obvious to modify the teachings of AAPA of “subject (person) authentication” to include computer-implemented and authentication rules as taught by ROSS to obtain well known benefits of the online process (remote uses or anywhere) and convenience such as quick response.

Vice versa, the teachings of ROSS is cited above. It would have been obvious to modify the subject/person request from a client/user of ROSS wherein the subject/data is about an authenticity of a business partner as taught by AAPA as mere applying the same authentication/verification techniques to other type of subject/data or requested subject/data from the user or wherein the function or intended use of the subject/data is for authentication of a business partner.

As for dep. claim 2 (part of 1 above) which deals with automation parameters, this is taught in ROSS [0008]. Note that the automation step is well known step and is taught in GUSTAFSON col. 2, lines 50-55, or would have been obvious to a skilled artisan to do so to improve efficiency. See *In re Venner*, 120 USPQ 192, CCPA 1958.

As for dep. claims 3-5 (part of 1 above) which deals with well known computer data entry parameters, i.e. standard template for entry of data or filling out a form, this is taught in ROSS [0008].

As for dep. claim 6 (part of 1 above) which deals with well known authentication rules parameter, i.e. types of rules such as current transactions with trade reference, etc., this is fairly taught in ROSS [0004-0005][0014-0016].

As for dep. claim 7 (part of 1 above) which calls for the step of presenting a registration template, this is taught in ROSS Fig. 2, [0014].

As for dep. claims 8-9 (part of 1 above) which deals with well known matching parameters, i.e. other attributes such as license, professional membership, etc., these are fairly taught in ROSS [0004, 0008, 0014, 0021, 0034], Fig. 2. Moreover, this varies with the type of request, business entity, etc., and the selection of the desired information is within the knowledge of the skilled artisan, an experienced businessperson with many years of practical experience. Moreover, this is non-functional descriptive material (information) and generally receives no patentable weight unless there is a step for carrying out a transaction.

**As for independent system claims 10, 12-18**, which are merely the system to carry out the method claims 1-9 as cited above, they are rejected over the system/element to carry out each respective step of independent claim 1 and dep. claims 12-18 as rejected above.

Alternatively, the set up of a respective system to carry out the same method claim as shown in claim 1 would have been obvious to a skilled artisan. Figs. 1-2, [0008] of ROSS is a typical computer system for carrying out the method steps as shown in steps (a)-(e) above.



***Response to Arguments***

2. Applicant's arguments, see paper filed 7/14/08, with respect to the rejections of claims 1-18 have been fully considered and are not persuasive.

1) Applicant's comment on page 8, 2<sup>nd</sup> full paragraph, that AAPA fails to teach that the identity of a business partner is matched to a business data record by searching at least one database for a business data record as in claim 1, this is not found persuasive because as cited on page 1, line 8 to page 2, line 14 (or US 2003/0120614, paragraphs [0003]-[0004]) fairly teaches current method for determining authenticity of a business partner in response to a request of a user in an off-line or manual technique by entering the request of a user into a computer system associated with the business database, the authentication process then employs a matching technique to find a data record of a business in the business database that matches the identifying data of the business partner. The data record of the matched business is then assessed for authenticity. The request also provides some data that identifies the business partner {see page 1, lines 30-31 "*Current methods .... Use an off-line technique...*"}. AAPA fairly teaches the claimed invention except for carrying out using a computer or "computer-implemented" as shown in the preamble and carrying out step (d) according to a set of authentication rules.

2) In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant's citation of the teachings in Ross for arguments against the combination of the rejection as shown on pages 8-9 are not persuasive for the reasons set forth:

In a similar method for verification of user authentication, **ROSS** fairly teaches a computer-implemented method for a subject or data remote authentication submitted by a remote user to determine whether the subject/data is authenticate (or verification of requested subject /data or user authentication) and according to a set of authentication rules (d) {see [0004], [0008], [0014], [0025][0026], Fig. 1. The term "subject" refers to any person or entity being authenticated. User authentication is the process of determining whether the subject is who he claims to be. Note that ROSS also discloses the carrying out the steps online in the case of Web forms {see [0004], and [0008]}. It would have been obvious to modify the teachings of AAPA of "subject (person) authentication" to include computer-implemented and authentication rules as taught by ROSS to obtain well known benefits of the online process (remote uses or anywhere) and convenience such as quick response.

Moreover, as indicated above, independent method claim 1 basically requires:

1. (previously presented) A computer-implemented method for determining authenticity of a business partner in response to a request of a user comprising:
  - (a) receiving a request of a user;
  - (b) receiving an identity of said business partner from said user;

(c) matching said identity of said business partner to a business data record of a business that is one of a plurality of businesses by searching at least one database for said business data record having at least one data attribute that matches said identity, and

(d) processing at least one said data attribute of the matched said business data record according to a set of authentication rules; and

(e) notifying said user of the results.

3. It is the examiner's position that Applicant's non-responsive to the Examiner's lack of patentability of other claims is taken that the applicant has admitted that the rejections of these claims are valid and these claims stand or fall together with the specific claims argued by the applicant.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 2002/0091945, by Ross, teaches verification engine for user Authentication with various authentication rules, etc. teaches similar limitations as in the claimed invention and is cited here for applicant's awareness of potential use in the future if needed.

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

No claims are allowed.

6. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov).

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at (571) 272-6805.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/  
Primary Examiner, Art Unit 3689